

Remarks

Section 112

Applicant's claim 12 was rejected as containing subject matter not described in the specification. This claim has been canceled, obviating this rejection.

Section 103

The sole remaining issue is whether the applicant's claims are obvious in light of the cited art. A review of the cited references indicates that the rejection should be reconsidered.

An obviousness determination requires determining the scope and content of the prior art and ascertaining the differences between the cited art and the claims at issue. See Graham v. John Deere Co., 148 USPQ 459 (S.C. 1966). When applying 35 USC Section 103 in a finding of obviousness, the tenets of patent law require that the claimed invention be considered as a whole, that the cited references must suggest the desirability and thus the obviousness of making the claimed combination, that the cited references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention, and that the cited reference provide a reasonable expectation of success in practicing the claimed technology. See Hodosh v. Block Drug Co., Inc., 229 USPQ 182, 187 (Fed. Cir. 1986).

In the present Office action, applicant's claims 1, 2, 7, 9, 10, 12-16, 18, and 19 were found to be obvious in light of Jensen (U.S. Pat. No. 772360). A review of this reference and the present claims reveals that this reference does not render obvious the applicant's claims.

Each of the applicant's independent claims, and by extension the claims dependent on these claims, includes as claim limitations a first material of which the device is made (the fish bag) and a second material of the device is made

(namely netting). In claim 1 these materials are defined in means plus function language. In claim 7, these elements are claimed as the fish bag and a second open netting. In claim 14 these elements are claimed as a tubular bag formed of a webbing material and a netting. Claim 14 also notes that one element is placed at the transition between the netting and webbing material. If the fish bag and the netting were not separate materials, it would not make any sense for these elements to be included in the claim as separate elements. The only reasonable reading of the claims is that the fish bag and the netting must refer to two different materials.

The specification supports that two materials are used in the present device. In Figures 1 and 4, the shading plainly shows two separate materials: an elongate bag and an open netting material at the end of the bag. In Figure 4, these two materials are explicitly labeled with different reference numerals: the fish bag labeled as numeral 1 and the netting labeled as numeral 4. The specification specifies "a fish bag 1 being made of strong webbing. . . . To the ends of the fish bag 1 there is located a tubular second netting 4. At the transition between the fish bag 1 and the second netting 4, there is located a first purse line 5." (page 4, lines 12-20). The use of the term "transition" makes it explicitly clear that the fish bag and the netting are two separate materials. Thus both the claims and the specification indicate that the fish bag and the netting are two separate materials.

Jensen does not teach a device including both a fish bag and a netting and thus does not render obvious the applicant's claims. In finding claims 1, 7, and 14 obvious under Jensen, element 1 was cited as disclosing a fish bag. However, element 1 of Jensen is an open netting, and thus is not consistent with the use of the term "fish bag" as defined by the present application. In addition, the claimed second

netting is found to also be the fish bag, there cannot be a transition between materials, as claimed by the applicant.

The difference between the device claimed by the applicant and the device disclosed by Jensen is more than cosmetic. Jensen fails to address the problem solved by the present invention. Jensen teaches a device for the sorting and storage of fish. It is not possible to transport at speed fish held within the device taught by Jensen without harming the fish. If the Jensen device were used for fish transport, the fish would be driven to the back of the net when the speed at which the device were towed exceeded the swimming speed of the fish within this device. This would result in the fish being crushed and adversely affect the ability of fish to breathe. Two of the applicant's claimed elements act to prevent this. The fish bag regulates the free flow of water through the device. In addition, the purse lines at the transition between the fish bag and the netting allows the opening of the fish bag to be closed sufficiently so that some water continues to move through the bag during transport while preventing all of fish from being subjected to the full speed of the water as the device is towed.

Next, applicant's claims 8 and 17 were found to be obvious in light of Jensen in view of Ebata (U.S. Pat. No. 4,045,432). As already discussed, Jensen fails to disclose the elements of the claims 7 and 14, on which claims 8 and 14 depend. In addition, applicant's claims 8 and 17 include the element of locking rings. The Office action notes that this element is not found in Jensen. The Office action proceeds to note that Ebata discloses a plurality of nets connected together. Figure one of Ebata shows how this connection is effected, using a zipper.

First, there is no proper teaching to combine these references. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hind-sight based obviousness analysis is a rigorous application of the

requirement for a showing of the teaching or motivation to combine the prior art references." In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (internal citations omitted). "The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

No motivation at all is included within the reference or cited by the Office for the proposed combination. Nothing from either of the cited references is advanced to motivate such a combination. To the contrary, Ebata is directed to connection of elongate net edges using a zipper. Should Ebata be modified in the manner suggested (substitution of rings) it would be rendered unfit for its present purpose, namely the connection of elongate edges of a material.

In addition, Jensen is directed to a storage net for holding fish. Jensen teaches that the "net may be extended by lacing onto the ends other extension-nets" (Jensen col. 2, lines 65-67). Given that Jensen has disclosed a means for attaching together addition fish storage devices, a person of skill in the art would not only have no motivation for looking to other references to achieve this end, but would be led away from making such a combination.

The law requires a clear a particular citation from the references supporting the instant combination. No citation is given from either reference to support the

combination. This fact alone warrants withdrawing the instant rejection.

Even were the references to be combined, there is insufficient disclosure to render obvious these two claims. As noted above, Jensen fails to anticipate the applicant's claims. As also noted, Jensen actually teaches away from the use of rings, by teaching an alternative joining method for attaching netting structures. Ebata, which requires elongate material edges for joining, comes no closer to disclosing the claimed joining rings. This again warrants reconsideration of the rejection.

Finally applicant's claims 11 and 20 were found to be obvious under Jensen in view of Salmon (U.S. Pat. No. 3,509,848). Again reconsideration is warranted.

As noted, a combination is only proper is a clear a particular teaching from the cited references is advanced. In addition, the combination is improper if the proposed combination would render one of the disclosed devices unfit for use. Nothing from either reference has been advanced for the proposed combination. In addition, if the device of Jensen were to be towed, as the Office suggests, the fish would be crushed by being driven into the back of the net. Further, if Salmon's disclosed device for transport of fresh water, were adapted to adopt Jensen's open netting, transport of water would not be possible. Such a combination renders the devices of both references unfit for their stated purpose. As such it should be reconsidered and withdrawn.

Again, even were the references to be combined, as already noted, Jensen falls far short of disclosing sufficient structure to render obvious the underlying independent claims. This is a second reason to withdraw this rejection.

Conclusion

The applicant respectfully requests reconsideration in light of the foregoing amendments and remarks. A notice of allowance is earnestly solicited. If you have any questions relating to this matter, please call me at (408) 297-9733 between 9 am and 5 pm Pacific time.

CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313

Signed: *Sally Azevedo*
Typed Name: Sally Azevedo
Date: July 9, 2003

Respectfully submitted,

D. M. Schneck

David M. Schneck

Reg. No. 43,094

P.O. Box 2-E

San Jose, CA 95109-0005

(408) 297-9733